

Appl. No. 09/944,376
Amdt. Dated September 17, 2003
Reply to Office Action of June 17, 2003

• • REMARKS/ ARGUMENTS • •

The Official Action of June 17, 2003 has been thoroughly studied. Accordingly, the changes presented herein for the application, considered together with the following remarks, are believed to be sufficient to place the application into condition for allowance.

Claims 1-6 are pending in this application.

Claims 1-6 stand rejected under 35 U.S.C. §103(a) as being unpatentable over International Publication No. WO 95/19258 to Suzuki in view of U.S. Patent No. 6,361,527 to Van Gompel et al.

The Examiner has relied upon Suzuki as disclosing:

- “a method of stretching or activating a web;”
- “stretching the web to activate the web to provide a more elastic stretch to the web, which is advantageous as an elastic topsheet or backsheet of an article, i.e. diaper in a production line, i.e. a continuous feeding and production process;” and
- that “the elastic sheet can be stretched to provide a flexible and efficient fitting structure prior to using the elastic sheet in producing a product.”

The Examiner concedes that Suzuki does not disclose a method of bonding the elastic web to a second web by superimposing and joining the webs in an intermediate manner.

The Examiner as relied upon Van Gompel et al. as disclosing:

Appl. No. 09/944,376
Amdt. Dated September 17, 2003
Reply to Office Action of June 17, 2003

- “a method of forming three dimensional pocket garments;”
- “the garment is formed by superimposing an elastic backsheet and topsheet and connected together using adhesive spot bonding”;
- “the elastic backsheet would provide an elastic and tear resistance properties to the article;” and
- “the top sheet is a meltblown or spunbonded fabric, which is without additional mechanical entanglement.”

In combining the teachings of Suzuki and Van Gompel et al. the Examiner states that:

It would have been obvious....to bond an elastic backsheet to a topsheet as disclosed by Van Gompel et al in the method of Suzuki to provide an article with elastic and tear resistance properties.

The Examiner has identified at least three features taught by Suzuki above and four features taught by Van Gompel et al.

However, it is not clear how the Examiner proposes to combine the teachings of Suzuki and Van Gompel et al.

The Examiner states that “[i]t would have been obvious....to bond an elastic backsheet to a topsheet as disclosed by Van Gompel et al in the method of Suzuki.”

It seems that the Examiner is taking the position that it would have been obvious to use the backsheet and/or topsheet of Van Gompel et al. in the method taught by Suzuki

This appears to be the case, because the Examiner’s stated motivation of the combination is to “provide an article with elastic and tear resistance properties.” This statement is similar to the

Appl. No. 09/944,376
Amdt. Dated September 17, 2003
Reply to Office Action of June 17, 2003

Examiner stated reliance upon Van Gompel et al. as teaching that "the elastic backsheet would provide an elastic and tear resistance properties to the article."

Moreover, on page 5 of the Official Action the Examiner states that Suzuki has been relied upon "to provide a teaching for stretch activating the first web, i.e. the composite laminate with a elastic sheet and a nonwoven fabric" and Van Gompel et al. has been relied upon "to provide the teaching of superimposing the topsheet, i.e. the first web, and backsheet, i.e. second web, which is formed by meltblown or spunbonded web without additional mechanical entanglement, and spot bonding the webs together to form the article."

Suzuki teaches a stretch-activated elastic composition that includes a non-woven fabric 21, 22 and an elastic sheet 11, 12. The non-woven fabric and elastic sheet are bonded together while the elastic sheet is in an unstretched state and thereafter stretched to activate the composite and produce a composite that "provides excellent performance in elastic recovery."

Neither the topsheet 28 nor the backsheet 30 of Van Gompel et al. are taught to be elastic or capable of elastic stretch and contraction.

Suzuki specifically teaches that:

In order to optimize the elastic composite structure in accordance with the present invention, it becomes important to combine respective characteristics of the non-woven fabric and the elastic sheet thereby improving their functions synergistically.

Moreover, Suzuki teaches the use of an "expandable, hydro-entangled non-woven fabric."

Appl. No. 09/944,376
Amdt. Dated September 17, 2003
Reply to Office Action of June 17, 2003

Accordingly, there is no basis whatsoever to presume or conclude that the backsheet of Van Gompel et al. could be substituted for the non-woven fabric of Suzuki and provide the required synergistic function with the elastic sheet of Suzuki.

As held by the court of appeals in *In re Wesslau*:

It is impermissible within the framework of Section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. *In re Wesslau*, 147 USPQ 391 (CCPA 1965)

In the present situation Suzuki teaches a particular (synergistic) combination of an elastic sheet and an "expandable, hydro-entangled non-woven fabric." Van Gompel et al. teaches the combination of two non-elastic layers.

Applying the holding in *In re Wesslau*, and giving full appreciation to the teachings of Suzuki and Van Gompel et al., it is submitted that the teachings of these references, including the clearly distinct structural and functional differences, preclude obviousness of their combination under 35 U.S.C. §103.

It is not enough that the Van Gompel et al., according to the Examiner, teaches "superimposing the topsheet, i.e. the first web, and backsheet, i.e. second web, which is formed by meltblown or spunbonded web without additional mechanical entanglement, and spot bonding the webs together to form the article."

There must be some suggestion or motivation within the teachings of Suzuki and Van Gompel et al. that suggests incorporating the backsheet of Van Gompel et al. into the stretch-

Appl. No. 09/944,376
Amdt. Dated September 17, 2003
Reply to Office Action of June 17, 2003

activated composite of Suzuki. Applicant's own disclosure cannot be relied upon for this required motivation or suggestion.

The Examiner cannot pick and choose among the individual elements of assorted prior art references to recreate the claimed invention; the Examiner has the burden to show some teaching or suggestion in the references to support their use in the particular claimed combination. See *Smithkline Diagnostics, Inc. v. Helena Laboratories Corp.*, 8 USPQ 2d 1468, 1475 (Fed. Cir.1988).

Based upon the above distinctions between the prior art relied upon by the Examiner and the present invention, and the overall teachings of prior art, properly considered as a whole, it is respectfully submitted that the Examiner cannot rely upon the prior art as required under 35 U.S.C. §103 to establish a *prima facie* case of obviousness of applicant's claimed invention.

It is, therefore, submitted that any reliance upon prior art would be improper inasmuch as the prior art does not remotely anticipate, teach, suggest or render obvious the present invention.

It is submitted that the claims, as now amended, and the discussion contained herein clearly show that the claimed invention is novel and neither anticipated nor obvious over the teachings of the prior art and the outstanding rejection of the claims should hence be withdrawn.

Therefore, reconsideration and withdrawal of the outstanding rejection of the claims and an early allowance of the claims is believed to be in order.

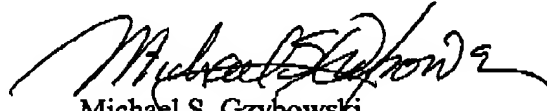
It is believed that the above represents a complete response to the Official Action and reconsideration is requested.

Appl. No. 09/944,376
Amdt. Dated September 17, 2003
Reply to Office Action of June 17, 2003

If upon consideration of the above, the Examiner should feel that there remains outstanding issues in the present application that could be resolved, the Examiner is invited to contact applicant's patent counsel at the telephone number given below to discuss such issues.

To the extent necessary, a petition for an extension of time under 37 CFR §1.136 is hereby made. Please charge the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 12-2136 and please credit any excess fees to such deposit account.

Respectfully submitted,


Michael S. Gzybowski
Reg. No. 32,816

BUTZEL LONG
350 South Main Street
Suite 300
Ann Arbor, Michigan 48104
(734) 995-3110

RECEIVED
OCT 29 2003
TC 1700

RECEIVED
CENTRAL FAX CENTER
SEP 17 2003

OFFICIAL

100491.1